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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,869	12/30/2003	Steve Hurson	NOBELB.163A	3711

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EXAMINER	
LEWIS, RALPH A	

ART UNIT	PAPER NUMBER
3732	

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/748,869	HURSON, STEVE	
	Examiner	Art Unit	
	Ralph A. Lewis	3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 September 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Drawings

The drawings filed 28 September 2005 are approved.

Rejections based on 35 U.S.C. 112, second paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The newly added limitation to claims 1 and 28 that the abutment portion includes a scalloped bone apposition surface contradicts applicant's description in the specification at paragraph 44 which indicates that the scalloped shape is part of the bone apposition surface 21 and paragraph 43 indicates the bone apposition surface 21 is part of the implant body portion 12, not the abutment portion 38 as is currently claimed.

Obvious-type Double Patenting Rejections

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-17 and 30-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,769,913 in view of Hurson WO 01/85050 and Wohrle (US 6,174,167). Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims of '913 teach the use of an impression cap with injection port and vent holes and use of a syringe to inject impression material into the cap through the injection port. Merely, providing for a '913 patented cap/method for use with the prior art Hurson implant with prior art scalloped edge as taught by Wohrle so that impressions may be made more accurately would have been obvious to one of ordinary skill in the art.

Rejections based on Prior Art

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4-11 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurson (WO 01/85050) in view of Wohrle (US 6,174,167).

Hurson discloses in '050 a dental implant having a body portion 10 for securement in a patient's jawbone 110 and an abutment portion 38 which extends above the jawbone 110. The abutment includes a shoulder portion 47 that lies between a lower flared portion and an upper restoration portion. Hurson further discloses a healing cap 76 with a cavity for fitting over the restoration portion and a tissue retention flange 86 that extends below the shoulder 47 of the abutment portion. In regard to claim 2, the abutment portion and the implant are capable of being permanently attached to one another if that is what one desired.

Hurson meets all the limitations of the present claims with the exception of the newly added limitation that the implant includes a scallop shaped bone apposition surface. Such a scalloped bone apposition shape is already known in the art as is disclosed by Wohrle who teaches that it is desirable to provide for such a shape in order to better maintain both the hard bone tissues and the soft gum tissues into which the implant is to be implanted. To have provided the prior art Hurson '050 implant 10 with such a prior art scalloped bone apposition surface as taught by Wohrle in order to better maintain the bone and gum tissues in which the Hurson implant is to be implanted would have been obvious to one of ordinary skill in the art.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurson (WO 01/85050) and Wohrle (US 6,174,167) as applied above and in further view of Kamiya et al (US 5,205,745).

Kamiya et al teach that it is known to combine the implant and the abutment of the implant into a single piece, thereby eliminating the need for costy interfitting pieces. To have constructed the Hurson implant and abutment as a single piece as taught by Kamiya in order to reduce the cost would have been obvious to one of ordinary skill in the art.

Claims 18-27 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hurson (WO 01/85050) and Wohrle (US 6,174,167) as applied above and in further view of Marlin (US 5,135,395) and Meiers et al (US 5,688,123).

Hurson fails to disclose a procedure for manufacturing a prosthesis for the implant disclosed. Marlin teaches the conventional manufacture of a prosthesis with a plastic coping that precisely fits over the abutment, encasing it in stone and then burning out the coupling leaving an opening in which the prosthesis is cast. To have provided a coping that precisely fits the Hurson abutment (e.g. one shaped like Meiers et al with "standoff" 5) and then using the coping to construct a prosthesis in a prior art investment cast technique as that disclosed by Marlin would have been obvious to one of ordinary skill in the art in desiring to construct a prosthesis for the Hurson implant.

Allowable Subject Matter

Claims 12-17 and 30-34 would be allowable upon the filing of a terminal claimer to overcome the obvious-type double patenting rejection above and if rewritten in independent form to include all of the limitations of the claims from which they depend and rewritten to overcome the 35 U.S.C. 112, second paragraph rejection above.

Action Made Final

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712.** Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (571) 272-4720.

R.Lewis
January 6, 2006

Ralph A. Lewis
Primary Examiner
AU 3732